

### REMARKS

The Patent and Trademark Non-final Office Action mailed March 14, 2008, has been carefully considered. The Examiner's rejection of claims 1 - 3, 5, 7, 26, 27, 29, 31 and 50 - 52 in view of the cited art is noted.<sup>1</sup>

Applicant has amended claims 2, 26, and 51 consistent with the specification. No new matter has been added by these amendments.

Applicant appreciates the Examiner's position with respect to claims 4, 6, 8 - 25, 28, 30, 32 - 49, and 53 - 57 being allowable if written in independent form, including all of the limitations of the base claim and any intervening claims.

#### Claim Rejections under 35 U.S.C. §102(e):

Claims 1 and 50 stand rejected under 35 U.S.C. §102(e) as being anticipated by U. S. Patent No. 6,752,566 to Smith.

Applicant files with this response a declaration under 37 C.F.R. §1.131 as to Applicant's adjudicated co-inventor status on U. S. Patent No. 6,752,566 [Declaration Exhibit "A"], and Applicant's present sole ownership of U. S. Patent No. 6,752,566 [Declaration Exhibit "B"] and its parent, U.S. Patent No. 6,595,718 [Declaration Exhibit "C"].

Accordingly, Applicant respectfully submits that the Patent

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<sup>1</sup> In a telephonic interview between Examiner Katcheves and the undersigned attorney on May 27, 2008, the Patent Office clarified which claims stood "rejected" as opposed to those which stood "objected to as depending upon a rejected base claim."

Office's rejection of claims 1 and 50 under 35 U.S.C. §102(e) as being anticipated by U. S. Patent No. 6,752,566 is traversed, See, e.g., *Riverwood Int'l v. R. A. Jones & Co.*, 324 F. 3d 1346, 1355 - 56, 66 U.S.P.Q. 2d 1331, 1338 (Fed. Cir. 2003) "[J]ust as a patent issued to the same inventive entity cannot be prior art by admission, an application issued to the same inventive entity cannot be prior art under §102(e)."

Additionally, the application (U.S. Non-provisional Patent Application 10/455,117) which matured into U. S. Patent No. 6,752,566 was filed on June 4, 2003, as a continuation-in-part application of Application No. 09/682,546, filed on September 19, 2001, now U.S. Patent No. 6,595,718. Applicant's application was filed April 12, 2004, claiming the benefit of Applicant's U.S. Provisional Patent Application No. 60/462,798, filed April 14, 2003. The new matter provided by (U.S. Non-provisional Patent Application 10/455,117) principally concerns the embodiments depicted in Figs. 12 - 23 [See, U. S. Patent No. 6,752,566, drawing sheets 7 - 10]. Accordingly, Applicant's constructive reduction to practice predates that of U. S. Patent No. 6,752,566, and arguably serves as a separate and independent basis to remove U. S. Patent No. 6,752,566 as a reference under 35 U.S.C. §102(e).

Applicant therefore requests the present status of claims 1 and 50 as being rejected under 35 U.S.C. §102(e) be reconsidered

and withdrawn by the Patent Office in view of: 1) Applicant's co-inventor status on U. S. Patent No. 6,752,566 as evidenced herein; 2) Applicant's prior constructive reduction to practice as detailed herein; or 3) both circumstances of numbers 1 and 2, *infra*.

**Claim Rejections under 35 U.S.C. §103(a):**

**A.** The Patent Office's rejection of claims 2, 26, 27, 29, 31 and 51 under 35 U.S.C. §103(a) as being unpatentable over Smith, U.S. Patent No. 6,752,566 ("Smith") in view of Kieranen, et al., U.S. Patent No. 7,144,191 ("Kieranen") is noted.

**Claims 2, 26, and 51:** As to claims 2, 26, and 51, Applicant has amended each of claims 2, 26 and 51 to include the specified bar code element [Application Serial No. 10/823,438; specification, page 27, lines 7 - 13] useful in removal and replacement of the broken concrete.

As amended, Applicant respectfully submits claims 2, 26, and 51 traverse the section 103(a) obviousness rejection since neither Smith or Kieranen suggest the limitation of "bar code means for identifying at least one cut slab and locating its position within the roadway using global positioning means." *See, e.g., In re Wada and Murphy*, Appeal 2007-3733 (B.P.A.I. 2008), citing *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F. 3d 1333, 1342 (Fed. Cir. 2003), and *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974).

Applicant respectfully submits the rejection of claims 2, 26, and 51 under 35 U.S.C. §103(a) as being unpatentable over Smith in view of Kieranen is traversed by Applicant's amendment as set forth above. Reconsideration and withdrawal of the 35 U.S.C. §103(a) rejection is requested for claims 2, 26, and 51.

Claims 27, 29, and 31: In view of Applicant's amendments to claim 26, and Applicant's further discussion of independent basis for reconsidering claim 26, claims 27, 29 and 31 flow from an allowable independent claim, and as such are allowable.

Further, the Patent office holds claims 27, 29 and 31 as being obvious under 35 U.S.C. §103(a) as being unpatentable over Smith since Smith "discloses the removing means as having solid metal (steel) plates (fig. 16: see flat plate portions) having holes therethrough and lift points (fig. 16: see lift points by cable 117), means for anchoring the plates to the concrete (fig. 22) and crane lifting means (117) interior of the outer edges." [Detailed Action, pages 3 - 4].

Use of Smith to in any way supply the disclosed or claimed subject matter of Applicant's disclosed and claimed subject matter in claims 27, 29, and 31 of the pending application must satisfy the factual inquiry requirements of *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), namely:

1. determining the scope and content of the prior art;
2. ascertaining the differences between the claimed invention

and the prior art; and

3. resolving the level of ordinary skill in the pertinent art.

For the second *Graham* factor, ascertaining the differences between the claimed invention and the prior art requires interpreting the claim language, MPEP §2111, and considering the invention and the prior art as a whole, MPEP §2141.02.

The disclosed system/apparatus and method of the present invention in the pending application provides "a plate of solid material" as the principal element affixed to the broken concrete slab [Application Serial No. 10/823,438; specification, page 11, lines 11 - 13]. Smith recites an *adjustable frame* "that is completely collapsible into single beam sections that can typically be lifted, maneuvered and bolted in place by a two-person crew, without use of equipment." [Smith, Column 3, lines 40 - 42]. Smith never mentions use of plates, and is consistent with a disclosed and claimed apparatus comprising an external, adjustable structural frame with upper and lower transverse members [See, e.g. Smith, Column 2, lines 4 -6 and 31 - 33; Column 3, lines 40 - 42, and 51, 60 - 61; Column 5, lines 1 - 3, 6 - 7, and 38 - 40; Column 8, lines 26 - 28; Column 10, lines 2 - 8 and 23 - 28; Column 11, lines 2 - 3; Claims 3, 9, 12, 14, and 26]. None of Smith's recited adjustable frame lifting structures include a plate of solid material.

Further, Smith does not disclose or claim attachment to broken

concrete pieces through holes in a solid plate but instead by slots in the adjustable frame elements [See, e.g., Smith, Column 7, lines 39 - 44; Claims 12, 13].

Accordingly, Applicant's solid plate structure affords the advantages over the Smith adjustable frame structure for concrete removal as summarized and detailed in the comparison of features set forth in Exhibit "D" to Applicant's Rule 131 Declaration filed with this response, which is incorporated herein by reference for all purposes. These comparison of features may be summarized as follows: Applicant's plate: 1) attaches to the slabs through short coil rods through holes in the solid metal plate; 2) eliminates torque issue from irregular shaped pieces of broken concrete; 3) eliminates belly sag of the concrete; and 4) reduces the time and labor required for removal of the broken concrete slab from the roadbed [See also, Application Serial No. 10/823,438 specification, page 12, line 13 through page 13, line 20]. All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 1596 (Fed. Cir. 1988).

Applicant respectfully submits the rejection of claims 27, 29, and 31 under 35 U.S.C. §103(a) as being unpatentable over Smith

is traversed as failing to meet the *Graham* requirements, particularly requirement numbers 1 and 2 - determining the scope and content of the prior art and ascertaining the differences between the claimed invention and the prior art, respectively. Reconsideration and withdrawal of the 35 U.S.C. §103(a) rejection is requested for claims 27, 29, and 31.

B. The Patent Office's rejection of claims 3, 5, 7 and 52 under 35 U.S.C. §103(a) as being unpatentable over Smith, U.S. Patent No. 6,752,566 ("Smith") is noted.

Claims 3, 5, 7, and 52: The Patent office holds claims 3, 5, 7, and 52 as being obvious under 35 U.S.C. §103(a) as being unpatentable over Smith since Smith "discloses the removing means as having solid metal (steel) plates (fig. 16: see flat plate portions) having holes therethrough and lift points (fig. 16: see lift points by cable 117), means for anchoring the plates to the concrete (fig. 22) and crane lifting means (117) interior of the outer edges." [Detailed Action, page 4].

Use of Smith to in any way supply the disclosed or claimed subject matter of Applicant's disclosed and claimed subject matter in claims 3, 5, 7, and 52 of the pending application must satisfy the factual inquiry requirements of *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), namely:

1. determining the scope and content of the prior art;
2. ascertaining the differences between the claimed invention

and the prior art; and

3. resolving the level of ordinary skill in the pertinent art.

For the second *Graham* factor, ascertaining the differences between the claimed invention and the prior art requires interpreting the claim language, MPEP §2111, and considering the invention and the prior art as a whole, MPEP §2141.02.

The disclosed system/apparatus and method of the present invention in the pending application provides "a plate of solid material" as the principal element affixed to the broken concrete slab [Application Serial No. 10/823,438; specification, page 11, lines 11 - 13]. Smith recites an *adjustable frame* "that is completely collapsible into single beam sections that can typically be lifted, maneuvered and bolted in place by a two-person crew, without use of equipment." [Smith, Column 3, lines 40 - 42]. Smith never mentions use of plates, and is consistent with a disclosed and claimed apparatus comprising an external, adjustable structural frame with upper and lower transverse members [See, e.g. Smith, Column 2, lines 4 -6 and 31 - 33; Column 3, lines 40 - 42, and 51, 60 - 61; Column 5, lines 1 - 3, 6 - 7, and 38 - 40; Column 8, lines 26 - 28; Column 10, lines 2 - 8 and 23 - 28; Column 11, lines 2 - 3; Claims 3, 9, 12, 14, and 26]. None of Smith's recited adjustable frame lifting structures include a plate of solid material.

Further, Smith does not disclose or claim attachment to broken



concrete pieces through holes in a solid plate but instead by slots in the adjustable frame elements [See, e.g., Smith, Column 7, lines 39 - 44; Claims 12, 13].

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Applicant respectfully submits the rejection of claims 3, 5, 7, and 52 under 35 U.S.C. §103(a) as being unpatentable over

Smith is traversed as failing to meet the *Graham* requirements, particularly requirement numbers 1 and 2 - determining the scope and content of the prior art and ascertaining the differences between the claimed invention and the prior art, respectively. Reconsideration and withdrawal of the 35 U.S.C. §103(a) rejection is requested for claims 3, 5, 7, and 52.

**Claim Objections:**

Claims 4, 6, 8 - 25, 28, 30, 32 - 49 and 53 - 57 stand objected to as being dependent upon a rejected base claim. Applicant respectfully submits the rejected base claims relating to these objections have been corrected and/or traversed by the amendment and discussion set forth herein above. In view of the same, reconsideration and withdrawal of the objections is requested for claims 4, 6, 8 - 25, 28, 30, 32 - 49 and 53 - 57.

**Conclusion**

In view of the foregoing, Applicant respectfully submits that the independent claims patentably define the present invention over the citations of record. Further, the dependent claims should also be allowable for the same reasons as their respective base claims and further due to the additional features that they recite. Separate and individual reconsideration of the dependent claims is respectfully requested.

Any claim amendments which are not specifically discussed in the above remarks are not made for reasons of patentability, do

not affect the scope of the claims, and it is respectfully submitted that the claims satisfy the statutory requirements for patentability without entry of such amendments. These amendments have only been made to increase claim readability, to improve grammar, or to reduce the time and effort required of those in the art to clearly understand the scope of the disclosed specification and claimed subject matter.

In view of the foregoing remarks, Applicant respectfully submits that all of the Patent Office's objections have been addressed and corrected and that all of the Patent Office's rejections have been overcome. Accordingly, allowance is earnestly solicited. If the Patent Office deems that a telephone interview could expedite resolution of any remaining issues, the Examiner is encouraged to contact Applicant's undersigned Attorney at the telephone number listed below.

Dated: June 5, 2008.

Respectfully submitted,  
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Enclosures:

1. Declaration of William M. Drake with Exhibits "A," "B," "C," and "D" [9 pages]; and
2. Transmittal [1 page].

CERTIFICATE OF MAILING 37 C.F.R. § 1.8

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cc: William M. Drake (w/encl.)